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Walter D. Buist

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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Acknowledgements

1. This application is currently on appeal to the USPTO's Board of Patent Appeals and Interferences ("Board").
2. A decision by the Board affirming the Examiner's rejection of claims 1-24 was mailed by the USPTO on December 29, 2008 ("2008 Board Decision").
3. In response to the 2008 Board Decision, Applicant filed a "Request for Rehearing and Supporting Brief" on February 26, 2009 ("Feb 2009 Request").
4. After review of the record in this application and as of the date indicated by the undersigned below, the Examiner finds that there are no outstanding amendments (including claim amendments).
5. This paper has been assigned Paper No 20090515. Paper No. is for reference purposes only.
6. Because of the Feb 2009 Request, the Board currently has jurisdiction of this application.

The Feb 2009 Request

7. In the Feb 2009 Request, Applicant presents three arguments as to why reconsideration is warranted. (Feb 2009 Request, pg 2). In particular, Applicant first argues that the Board misapprehended the legal standard for inherent anticipation. Second, Applicant argues that the Board misapprehended the Hausman reference. Third, Applicant argues that "method Claims 1, 7, and 13, *could* readily be amended to address an argument raised for the first time in the Examiner's Answer" (Feb 2009 Request, pg 2, lines 3-9)(emphasis added).

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8. Regarding Applicant's first argument, the Examiner has not had a chance to address Applicant's argument. The Feb 2009 Request is the first time Applicant has made this argument.

9. Regarding Applicant's second argument, the Examiner respectfully disagrees and believes that further discussion will support the Examiner's position.

10. Regarding Applicant's third argument, the Examiner's factual finding (in ¶ 4. above) indicates that Applicant has not yet made *any* claim amendments.

Request By Examiner To Remand

11. The Examiner notes that the Board has the authority to remand appeals to examiners for further consideration pursuant to 37 C.F.R. § 41.50(a)(1). See MPEP §1211. Additionally, MPEP §1211 also states that "the Board may remand an application to the examiner to prepare a supplemental examiner's answer in response to a reply brief."¹

12. While the MPEP does not *expressly* state the Board can remand the application to the examiner in response to a request for rehearing, it is the Examiner's position the same reasoning which allows for remand in response to a reply brief is also applicable in this application.

Namely to address issues never considered by the Examiner.

13. Because the Examiner has not had a chance to address Applicant's first argument, because the Examiner believes that the Board did not misapprehend Hausman, and because no amendments are present in this appeal, the Examiner respectfully requests that the Board remand

¹ Alternatively, the Board always has the authority under 37 C.F.R. § 41.50(a)(1) to remand the application to the Examiner to reopen prosecution for other reasons such as for a determination as to whether or not the claims are directed statutory subject matter in accordance with *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)(en banc), whether or not claim terms and/or phrases are terms or art, or for other reason(s) addressed in the due course of ex parte examination.

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this application to the Examiner for the limited purpose of addressing only the points made by Applicant in the Feb 2009 Request.

14. Alternatively, should *Applicant* (and not the Board) decide to reopen prosecution by filing *e.g.* a claim amendment, a reply under 37 C.F.R. §1.111(b), or any other request that results in reopening prosecution, the Examiner will proceed with the full scope *ex parte* examination. This will best provide Applicant with his chance (as noted in his Feb 2009 Request, pg 2, lines 7-10) to amend claims 1, 7 and 13 accordingly.

15. For the reasons stated above, the Examiner respectfully request that this application and jurisdiction of this application be remanded to the Examiner.

16. Respectfully submitted,

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621
May 16, 2009